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10/085,601	02/27/2002	Daniel Tsu-Fang Wang	VTN-0583	8603

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EXAMINER

BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/085,601

Applicant(s)

WANG ET AL.

Examiner

Michael Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 19-24 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 19-24 and 26-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action, and apply to this and any subsequent Office Actions.

***Priority***

1. Applicant's claim of priority to application 09/945859 filed 2/1/00 is made is acknowledged.

***Drawings***

2. New drawings will be required contingent upon allowance because the drawings were objected to by the draftsman/declared informal by the applicant.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 19, 20, 29, 30, and 32, 33, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al. '957 which discloses:

(Re: cl 19, 36) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and

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printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product.(abstract)

wherein the prescription product is a contact lens (abstract)

(Re: cl 20). printing step entails printing said customized graphics on primary packaging for said prescription product (abstract)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system (abstract)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing out said customized graphics for said packaging for said prescription product.

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means.

(Re: cl 33). wherein each of said labels is for a particular ordered prescription product, and said system matches up said prescription product with said label (abstract).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19, 21, 22, 24, 26-30, 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hebron et al. and Edwards et al. '297 (5776297) wherein Hebron et al. discloses robotic prescription printing packaging system comprising:

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product (c2 L 1-33)

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product (c5 L 52-c6 L 3)

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(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label (c5 L 52-c6 L 3)

(Re: cl 24). wherein after said printing step the method further comprises the step of adhering said label onto said packaging (c5 L 52-67)

(Re: cl 26) wherein said label has a label identification means (c 15 L 5-24)

(re 27) wherein said packaging has a product machine readable code, and said method further comprises the step of checking said label identification means and said product machine readable code before said adhering step (c9 L 10-19)

(Re: cl 28) wherein said method further comprises the step of picking said prescription product in customary packaging from inventory and diverting it to a customized graphics printing system prior to said checking step (c5 L 52-c6 L 3)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system (c5 L 52-c6 L 3)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing)out said customized graphics for said packaging for said prescription product (c2 L 1-33)

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means ( c9 L 10-19)

(Re: cl 33). wherein each of said labels is for a particular ordered prescription product, and said system matches up said prescription product with said label (c 15 L 5-24)

(Re: cl 34) further comprising a quality check station (c9 L 10-19)

(Re: cl 35) further comprising a label applicator (c5 L 52-67).

Edwards et al. '297 discloses:

the prescription product is a contact lens c4 L 12-50-

It would have been obvious at the time of the invention for Hebron et al. to include customized printing on prepackaged custom contact lenses packaging and labels to insure patients are getting the proper prescribed lenses as taught by Edwards et al. '297 and come up with the instant invention.

7. Claims 19, 21, 22, 26-30, and 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charhut et al. '829 (per original issue patent 5208762) and Edwards et al. '297 (5776297) wherein Hebron et al. discloses robotic prescription printing packaging system comprising:

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(Re: cl 19,36) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product (c3 L 6-41)

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product (c4 L 1-24)

(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label (c4 L 1-9)

(Re: cl 26) wherein said label has a label identification means (c 15 L 5-24)

(re 27) wherein said packaging has a product machine readable code, and said method further comprises the step of checking said label identification means and said product machine readable code before said adhering step (c4 L 10-24; H(c9 L 10-19)

(Re: cl 28) wherein said method further comprises the step of picking said prescription product in customary packaging from inventory and diverting it to a customized graphics printing system prior to said checking step (c4 L 34-c5 L 25)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system (c4 L 1-9)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing)out said customized graphics for said packaging for said prescription product (c3 L 6-41).

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means (c4 L 10-24).

Edwards et al. '297 discloses:

the prescription product is a contact lens c4 L 12-50-

It would have been obvious at the time of the invention for Charhut et al. '829. to include customized printing on prepackaged custom contact lenses packaging and labels to insure patients are getting the proper prescribed lenses as taught by Edwards et al. '297 and come up with the instant invention.

8. Claims 19, 21, 22, 26-30, and 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charhut et al. '829 (per original issue patent 5208762) and Pauly

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et al. (EP 0299690 A2) wherein Charhut et al. discloses robotic prescription printing packaging system previously discussed and

Pauly et al. discloses:

the prescription product is a contact lens with custom printed instructions from a prescriber printed on the package labels (abstract)..

It would have been obvious at the time of the invention for Charhut et al. '829. to include customized printing on prepackaged custom contact lenses packaging and labels to insure patients are getting the proper prescribed lenses as taught by Pauly et al. and come up with the instant invention.

9. Claims 19, 21, 22, 29, 30, and 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum and Pauly et al. (EP 0299690 A2) wherein Baum discloses prescription printing packaging system previously discussed and

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product (abstract)

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product. (c3 L 19-33)

(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label (abstract)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system c3 L 19-33)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing out said customized graphics for said packaging for said prescription product (abstract)

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means (fig 3).

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Pauly et al. (EP 0299690 A2) discloses:

the prescription product is a contact lens with custom printed instructions from a prescriber printed on the package labels (abstract)..

It would have been obvious at the time of the invention for Baum to include customized printing on prepackaged custom contact lenses packaging and labels to insure patients are getting the proper prescribed lenses as taught by Pauly et al. and come up with the instant invention.

10. Claims 19, 20, 23, and 29-33 and 36 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. '957 in view of Marino, Jr. et al. wherein Martin et al. '957 discloses the elements previously discussed and Marino, Jr. et al. discloses and elements not explicitly taught by Martin et al. '957 including:

(re : cl 23) apparatus and method for applying varnish to the label (c3 L 13-19).

It would have been obvious at the time of the invention for Martin et al. '957 to use a varnish applicator to varnish the labels to stabilize the coatings and printing as taught by Marino, Jr. et al. al. and come up with the instant invention.

### ***Response to Amendments/Arguments***

11. Applicant's pointing out the location of the varnish application in the specification was effective in overcoming the rejection under 35 USC 112 1<sup>st</sup> paragraph. Applicant's amendments were effective in overcoming the rejections under 35 USC 112 second paragraph. Applicant's amendment to the independent claims were effective in overcoming the anticipatory rejections evidenced by Hebron et al., Charhut et al. , and Baum.



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Applicant's arguments were ineffective in distinguishing the claims from the references involving Martin. It doesn't matter what the purpose of the printed graphics are-orders are still printed graphically.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

*Michael E. Butler*

Michael E. Butler  
Examiner

*Donald P. Walsh*  
DONALD P. WALSH  
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